

## **REMARKS**

### **Formal Matters**

Claims 1, 4 and 39 remain pending in this application without amendment.

### **Rejection Under 35 U.S.C. § 102(e) (US6,727,077)**

Claims 1, 4 and 39 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Young (U.S. Patent 6,727,077; issued Apr. 27, 2004 from Provisional application 60/049,492, filed on June 17, 1997). Applicants respectfully traverse the rejection as applied and as it might be applied to the currently pending claims for the reasons provided below.

US Patent 6,727,077 was issued from Provisional application 60/049,492, filed on June 17, 1997. Applicants conceived and reduced to practice the claimed invention before June 17, 1997 as stated by the instant inventors in the Declaration under 37 CFR § 1.131 submitted herewith (unsigned). A fully signed copy of the declaration will be submitted to the Examiner in due course.

Inventors Paul J. Godowski, Melanie Rose Mark and Dong Xiao Zhang state that prior to June 17, 1997, they conceived of and reduced to practice an isolated amino acid sequence comprising an EGF-like domain of NRG3. Support for the statement is provided in Exhibit A, attached thereto. Exhibit A is a computer printout of an amino acid sequence of NRL, designated NRG3 in the present application. The date and non-EGF-like domain sequence information have been redacted. The EGF-like domain label and underlining have been added for the purpose of this Response. The amino acid sequence of the EGF-like domain conceived and reduced to practice by Applicants prior to June 17, 1997 (shown in Exhibit A) is the same as the amino acid sequence from amino acid 31 to 77 of SEQ ID NO:2 of US Patent 6,727,077. Thus, Applicants' claimed invention was conceived and reduced to practice before June 17, 1997, the indicated filing date of Provisional application 60/049,492 from which US Patent 6,727,077 issued. As a result, US6,727,077 does not anticipate Applicants' claimed invention.

Having overcome the rejection under Section 102(e), the claims are in condition for allowance and withdrawal of the rejection is respectfully requested.

SUMMARY

Claims 1, 4 and 39 are pending in the application. The rejection under 35 U.S.C. § 102(e) in view of US6,727,077 has been overcome by submission of a declaration under 37 CFR 1.131.

If in the opinion of the Examiner, a **telephone conference** would expedite the prosecution of the subject application, the Examiner is **strongly encouraged** to call the undersigned at the number indicated below.

This response/amendment is submitted with a transmittal letter and petition for a three-month extension of time and fees. In the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

GENENTECH, INC.

Date: January 18, 2005

By: 

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